

REMARKS/ARGUMENTS

Favorable consideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-5 are pending and Claims 6-13 are canceled. Claim 4 is amended herewith. It is respectfully submitted that no new matter is added by this amendment.

In the Office Action dated January 12, 2004 in parent application Serial No. 10/298,514, the drawings were objected to under 37 C.F.R. § 1.81; and Claims 1-5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takahashi (Re. 36,818).

With regard to the objection to the drawing, this rejection is respectfully traversed. The Office Action states at page 2 that “the claimed emitters overlying the gate electrodes as in Claim 4 is not shown by any of the drawings.” Claim 4 has been amended to avoid reference to “emitters overlying the gate electrodes.” Accordingly, it is respectfully requested that the objection to the drawings be withdrawn.

With regard to the rejection of Claims 1-5 under 35 U.S.C. § 103(a) as unpatentable over Takahashi, that rejection is respectfully traversed.

Claim 1, from which Claims 2-5 depend, recites in part:

a plurality of gate electrodes ... each said gate electrode having an upper surface of a rectangular pattern with different widths in two orthogonal directions, said gate electrodes being disposed in a direction along a short side of the rectangular pattern ...

emitter layers of the second conductivity type formed in the surface of said base layer to oppose both end portions of each said gate electrode in a direction along a long side of the rectangular pattern.

The outstanding Office Action at page 3 admits that Takahashi “omits to mention that the gate electrode as having different widths in two orthogonal directions.” The Office Action then asserts, “However, the structure in the patent also has similar pattern when seen

from the three-dimensional point of view and the gate is formed in the trench in both directions for one to safely conclude the structure is similar to the claimed invention.”

Thus, it appears that the outstanding Office Action takes the position that the claimed configuration is inherent in Takahashi. However, this violates MPEP § 2112, which requires “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”¹ Moreover,

To establish inherency the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”²

Finally, MPEP § 2112 requires that “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”³

In this case, there is no basis in Takahashi (and none is cited by the Examiner) to conclude that Takahashi recites the claimed limitations. Moreover, while the Examiner states that one can “safely” conclude that the structure is “similar” to the claimed invention, this does not mean that Takahashi necessarily discloses the claimed invention, as required by MPEP §2112.

As the outstanding Office Action fails to satisfy the requirements set forth in MPEP § 2112, it is respectfully submitted that the outstanding Office Action has failed to provide a *prima facie* case of obviousness with regard to Claim 1. Therefore, it is respectfully submitted that Claims 1-5 patentably distinguish over Takahashi, and it is respectfully requested that the outstanding rejection of Claims 1-5 be withdrawn.

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original).

² In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

³ Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Attorney Docket No. 251173USUS2CONT
Inventor: Tadashi MATSUDA
Preliminary Amendment

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,


OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
EHK:KDP:smi:dmr

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Eckhard H. Kuesters
Registration No. 28,870
Katherine D. Pauley
Registration No. 50,607